



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,699	05/15/2006	Alexander Grinberg	37388-405600	8167
27717 7590 07/26/2011 SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803				
EXAMINER WONG, ERIC TAI WAI				
ART UNIT 3693		PAPER NUMBER		
MAIL DATE 07/26/2011		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,699

Applicant(s)

GRINBERG ET AL.

Examiner

ERIC T. WONG

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3, 5-18, 20-32, 34, 35, 37, 41, 45, 46, 48, 50 and 52-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 5-18, 20-32, 34, 35, 37, 41, 45, 46, 48, 50 and 52-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/8/2011 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 2, 3, 5-11, 15-18, 20-27, 31, 32, 34, 35, 45, 46, 48, 50, and 52-64** are rejected under 35 U.S.C. 102(b) as being anticipated by Linehan (US PAT 6,327,578).

4. **Regarding claims 53, 60, 63, and 64**, Linehan discloses:

- a transaction facilitating computing device including a processor, memory and software arranged to generate a payment gateway accessible by the customer computing device at a merchant network site generated by the merchant computing device (see FIG. 3, step 306]),
- the payment gateway arranged to initiate a payment process for the customer computing device to control payment to a merchant account from a customer controlled account of a financial institution associated with the customer, via a financial institution computing device and providing an interface means arranged to control the customer computing device to connect the customer computing device to a financial institution application provided by the financial institution computing device, the customer computing device being arranged to provide a security device via the connection to the financial institution application, in response the financial institution computing device

being arranged to process payment from the customer account to the merchant account, without the security device being transmitted via the merchant network site and merchant computer (see col. 7, line 55—col. 8, line 15, wherein the consumer logs on to the wallet, and the wallet sends the user's identification and authentication to issuer gateway; see also col. 14, lines 33-40; col. 9, lines 40-45)

- the system being arranged to enable provision of transaction details to the financial institution application, the provision of the transaction details only being enabled when the customer device is connected to the financial institution application (see col. 7, line 55—col. 8, line 15, wherein the consumer logs on to the wallet, and the wallet sends the user's identification, authentication, and “merchant message”, which contains an “initiation message”, which contains transaction details, to issuer gateway; see also col. 14, lines 33-40; col. 9, lines 40-45; col. 4, lines 10-24).

5. **Regarding claims 2 and 20**, Linehan discloses wherein the interface means is arranged to connect the customer computing device to the financial institution application in real-time to enable the payment to proceed in real time (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

6. **Regarding claims 3 and 21**, Linehan discloses wherein the interface means is arranged to connect the customer computing device to the financial institution application during the on-line product transaction to enable the payment to occur during the product transaction (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

7. **Regarding claims 5 and 22**, Linehan discloses wherein the interface means is arranged to generate confirmation to the merchant computing device that payment has occurred, the interface means connecting the financial institution computing device to the merchant computing device to enable confirmation (see col. 14, lines 27-54).

8. **Regarding claims 6 and 23**, Linehan discloses wherein the interface means is arranged to provide a secure connection between the financial institution computing device and the merchant computing device for generation of confirmation that payment has occurred (see col. 14, lines 27-54).

9. **Regarding claims 7 and 24**, Linehan discloses the interface means being arranged to obtain transaction details from the merchant network site and provide the transaction details to the financial institution application to facilitate payment (see col. 4, lines 10-24).

10. **Regarding claims 8 and 25**, Linehan discloses wherein the transaction details include the payment amount (see col. 4, lines 10-24).

11. **Regarding claims 9 and 26**, Linehan discloses wherein the transaction details include a merchant account identifier (see col. 15, lines 14-48).

12. **Regarding claim 10**, Linehan discloses wherein the financial institution application is a known pre-existing financial institution application (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

13. **Regarding claims 11 and 27**, Linehan discloses wherein the security device is provided by the customer entering the security device via the customer computing system (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

14. **Regarding claims 15 and 31**, Linehan discloses a database arranged to store transaction details of transactions (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

15. **Regarding claim 16**, Linehan discloses wherein the database is arranged to be accessible by the merchant computing device to enable a merchant to obtain details of transactions that they are associated with (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

16. **Regarding claim 17**, Linehan discloses wherein the database is arranged to be accessible by customer computing devices to enable customers to obtain details of transactions that they are associated with (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

17. **Regarding claims 18 and 32**, Linehan discloses wherein the interface means is an agent application (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

18. **Regarding claims 34, 35, and 45**, Linehan discloses a non-transitory computer readable medium and system to implement the system in accordance with claim 53 (see col. 8, lines 33-52)

19. **Regarding claims 46, 48, 50, and 52**, Linehan discloses wherein the financial institution application is an internet banking application; wherein the connection is implemented to connect the financial institution application to the customer computing system (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

20. **Regarding claims 54 and 61**, Linehan discloses wherein the interface means is arranged to automatically navigate the financial institution application to enter the transaction details (see col. 4, lines 10-24).

21. **Regarding claim 55**, Linehan discloses wherein the interface means is arranged to automatically navigate the merchant network site and obtain data from the merchant network site to obtain the transaction details (see col. 4, lines 10-24).

22. **Regarding claim 56**, Linehan discloses wherein the interface means is arranged to store the transaction details in the database (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

23. **Regarding claims 57 and 62**, Linehan discloses wherein the transaction facilitating computing device is arranged to download the agent application on initiation of the payment process (see col. 7, line 55—col. 8, line 15; col. 14, lines 33-40; col. 9, lines 40-45).

24. **Regarding claim 58**, Linehan discloses the system further comprising the financial institution application and financial institution computing device (see col. 15, lines 14-48).

25. **Regarding claim 59**, Linehan discloses the system further comprising the customer computing device (see col. 15, lines 14-48).

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. **Claims 12-14, 28-30, 37, and 41** rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan in view of Applicant admission of prior art.

28. **Regarding claims 12, 13, 28, and 29**, Linehan teaches claims 36 and 40. He does not teach encrypting and decrypting a security device. However, Applicant admits that it is old and well known in the finance arts to store a security device in encrypted form, and wherein the interface means is arranged to decrypt the encrypted security means. It would have been obvious to one of ordinary skill in the art at the time of the invention to use encryption with the storage device to add an extra layer of security to the transaction.

29. Examiner notes that Applicant did not traverse the Official Notice taken in the prior Office Action regarding the limitation. As such, the limitation is construed as Applicant admission of prior art.

30. **Regarding claims 14 and 30**, Linehan teaches claims 36 and 40. He does not teach encrypting and decrypting a security device. However, Applicant admits that it is old and well known in the finance arts for a system to include storage means for storing decryption keys for

decrypting encrypted security means. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a storage means for the decryption keys with motivation to provide an easier way to record and enter when needed the often lengthy and complicated decryption key. This is easier and faster than a user manually entering the decryption key each time decryption occurs.

31. Examiner notes that Applicant did not traverse the Official Notice taken in the prior Office Action regarding the limitation. As such, the limitation is construed as Applicant admission of prior art.

32. **Regarding claims 37 and 41**, Linehan teaches claims 36 and 40. He does not teach that the communications are in the form of e-mails. However, Applicant admits that it is old and well known in the finance arts to make communications in the form of e-mail messages. It would have been obvious to one of ordinary skill in the art at the time of the invention to communicate through e-mail messages to quickly communicate between parties.

33. Examiner notes that Applicant did not traverse the Official Notice taken in the prior Office Action regarding the limitation. As such, the limitation is construed as Applicant admission of prior art.

Response to Arguments

34. Applicant's arguments with respect to the rejections of claims 53, 60, 63, and 64, and their dependent claims, under 35 USC 102(a) and 35 USC 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is (571)270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC T. WONG/
Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

July 22, 2011